

REMARKS

Applicant believes that the foregoing amendments and the following comments will convince the Examiner that the rejections and objections provided in the June 03, 2003
5 Office Action have been overcome and should be withdrawn.

I. THE INVENTION

This invention relates to the field of ear protection systems, and in particular, means for stowage of protective 10 ear devices. Further, the invention relates to an encasement for ear protection devices with means for extension and retraction of protective ear devices that affords the user adjustability and versatility in placement of the encasement. The invention is designed to be 15 adaptable to any type of environment or situation a user may encounter where it is desirable to block out a harmful or disturbing noise.

II. THE EXAMINER'S OBJECTIONS

20 The Examiner objected to the drawings because Figure 3A was not included. Further, the drawings were objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the thumb

slide, the push button, and the ratchet were not shown in the drawings.

The disclosure was objected to because of the following informalities:

- 5 "On page 18, line 5, after 'upper section' should read --
305 -- instead of '304';
- On page 18, line 5 after 'lower section' should read
--304 -- instead of '305';".

10 The Abstract was objected to for not following proper language and format. Particularly, the Examiner noted that the "form and legal phraseology often used in patent claims, such as 'means' and 'said,' should be avoided."

III. THE EXAMINER'S REJECTIONS

15 A. 35 U.S.C. § 112

The Examiner rejected claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite. Particularly, the Examiner contended that there is "insufficient antecedent basis" for the limitation "said earplugs" in line 2 of the 20 claim. (paragraph 3).

B. 35 U.S.C. § 102(b)

The Examiner has rejected claims 15, 16, 18, 20, 22 through 32, 34, 35 and 37 under 35 U.S.C. § 102(b) as being anticipated by Nakano U.S. Patent No. 5,581,821

(hereinafter referred to as "Nakano"). The Examiner contended that Nakano teaches a method and system of ear protection comprising the steps of:

5 "providing an encasement structure comprising at least an anterior member (Fig.6, Item 25) and posterior member (Fig.6, Item 24), wherein the anterior member and the posterior member are removably coupled together, preventing the penetration of harmful sounds into the ear canal
10 by providing a plurality of ear protection devices (Fig.2, Items 15 and 17), selectively retracting the plurality of ear protection devices, wherein the selectively retracting is executed by retraction means (Fig.4), securely stowing the plurality of ear protection devices adjacent to the encasement structure; and mounting the encasement structure upon an entity for convenient placement of the encasement structure with removable mounting means(Figs.1-
15 3), and wherein the ear protection devices comprise earplugs (Fig.2, Items 15 and 17) (Col.2, Line 52 - Col.4, Line 36)." (Paragraph 4).
20

25 According to the Examiner, Nakano further teaches wherein the ear protection devices are removably coupled to the retraction means; wherein the retraction means comprises a cord mounted on a spool; wherein the retracting step comprises securing the extension of the plurality of
30 ear protection devices by a spring loaded locking mechanism; wherein the spring loaded locking mechanism comprises a push button and a ratchet; and wherein the mounting means comprises a clip-on means.

C. 35 U.S.C. § 103

1. Claims 21, 33 and 36

The Examiner rejected claims 21, 33 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Rozon U.S. Patent No. 5,279,473 (hereinafter referred to 5 as "Rozon"). The Examiner opined that Nakano discloses the claimed invention except for wherein the spring-loaded locking mechanism comprises a thumb slide and wherein the encasement structure is constructed of plastic. Rozon, in the opinion of the Examiner, teaches a cord retraction 10 device comprising a spring-loaded locking mechanism that comprises a thumb slide and wherein the encasement structure is constructed of plastic. The Examiner argued that it would be obvious "to employ the Rozon thumb slide with the Nakano system because the thumb slide is easy to 15 use and provide [sic] a good ergonomically fit actuator for a user to use." (paragraph 5).

2. Claim 38

The Examiner rejected claim 38 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Burger 20 U.S. Patent No. 4,802,638 (hereinafter referred to as "Burger"). The Examiner argued that it would have been obvious to employ the rotatable clip on means disclosed in Burger with the Nakano design because "it would provide a certain degree of movement that would prevent the cord from

get [sic] tangled with the surface of the enclosure." (paragraph 6).

3. Claims 1 through 9, 11 through 13, 17 and 19

The Examiner rejected claims 1 through 9, 11 through 5 13, 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Liao U.S. Patent No. 6,416,005 (hereinafter referred to as "Liao"). The Examiner argued that Nakano discloses the claimed invention with the exception of "a plurality of retraction means 10 disposed within the encasement structure." According to the Examiner, it would have been obvious "to employ a plurality of retraction means, as described by Liao, in the Nakano design." (paragraph 7).

4. Claims 6 and 10

15 Claims 6 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakano, in view of Liao, and further in view of Rozon. The Examiner contended that Nakano and Liao disclose the claimed invention with the exception wherein the spring-loaded locking mechanism 20 comprises a thumb slide and wherein the encasement structure is constructed of plastic. The Examiner stated that it would have been obvious "to employ the Rozon thumb slide with the Nakano and Liao system because the thumb

slide is easy to use and provide a good ergonomically fit actuator for a user to use." (paragraph 8).

5. Claim 14

The Examiner rejected Claim 14 under 35 U.S.C. § 5 103(a) as being unpatentable over Nakano in view of Liao, and further in view of Burger. The Examiner contended that Nakano and Liao disclose the claimed invention but fail to disclose the rotatable clip-on means. The Examiner found that it would have been obvious to employ the rotatable 10 clip-on means of Burger with the Nakano and Liao design "because it would provide a certain degree of movement that would prevent the cord from get tangle [sic] with the surface of the enclosure." (paragraph 9).

15 IV. THE EXAMINER'S OBJECTIONS AND REJECTIONS SHOULD BE WITHDRAWN

A. DRAWINGS

The Examiner objected to the drawings for not showing FIG. 3A. Applicant directs the Examiner's attention to the 20 drawings labeled "300". The drawing to the left has now been labeled FIG. 3A while the drawing to the right has now been labeled FIG. 3 to distinguish the front and side view drawings.

The Examiner also objected to the drawings for not showing every feature of the invention. Applicant has amended the drawings in accordance to show pushbutton 109, ratchet 110 and thumbslide 601. No new matter has been
5 added.

C. 35 U.S.C. § 112

The Examiner rejected claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite. In response, Applicant has amended claim 26 to avoid redundancy with
10 claim 27.

B. 35 U.S.C. § 102

The Examiner has rejected claims 15, 16, 18, 20, 22-32, 34, 35 and 37 under 35 U.S.C. § 102(b) as being anticipated by Nakano. Nakano is directed to an ear
15 protection device for attachment to a construction helmet.

The invention specifically relates to the field of construction, in which the ear protectors are designed to be readily accessible for use by a workman. Applicant respectfully submits that the teaching of Nakano is limited
20 to the use of an ear protection assembly in combination with headgear having a crown and a forwardly extending peak. Nakano specifically discloses:

"[A] reelable ear plug assembly detachably carried on a helmet 11, such as is used by a

construction worker. The helmet may be referred to as a construction helmet and the assembly is carried on a housing 12 which may be attached to the rear of the helmet, as shown, such as with adhesive or by a releasable clamp, or, if desired, the housing may be detachably connected to a brim or visor 13 formed with the crown of the helmet 11."

The specific design of the ear protection assembly device disclosed by Nakano limits the invention to specific placement on the brim or crown of a construction helmet. The device consists of only one retraction means which inhibits independent control of the left and right ear protection devices. Thus, placement of the encasement structure is limited to either the middle of the "forwardly extending peak" or the middle of the back of the headgear, i.e., somewhere that is an equal distance between the user's ears. The Nakano design further requires that the user utilize both earplug devices at the same time, or else one end of the cord would remain dangling, which defeats the objective of the cord stowage device. The limitation of placement of the encasement structure prevents the user from attaching the device to any article of clothing such as a shirt collar or pocket that may require unequal lengths of cord in order to reach each ear. Additionally, Nakano teaches away from an earplug device wherein the user only wishes to block noise on one side. For example, if a

user wishes to use a cell phone in a noisy environment, the user may wish to only use the ear protection device in one ear while keeping the plug for the other ear stored in the stowage device. The device of Nakano cannot accomplish 5 this. Thus, even the broadest reading of Nakano would require that the ear protection devices be used in conjunction with headgear that includes a crown and forwardly extending peak. Furthermore, Nakano only discusses an ear protection device where both earplug 10 devices must extend from the stowage compartment at equal lengths and at the same time. The present invention advances beyond Nakano because it does not need to be placed on headgear, does not need to be placed in a location equidistant from both ears, and the left and right 15 ear protection devices can extend and retract independent of the other.

Independent claims 15 and 24 have been amended to more clearly state this distinction discussed above. Specifically, these claims now require "a plurality of retraction means" and that the plurality of retraction 20 means "operate said plurality of ear protection devices independently." Minor amendments to some of their dependent claims have also been made for consistency.

The applicant acknowledges the Examiner's reliance on Liao as disclosing a plurality of retraction means. However, the applicant respectfully submits that the combination of Nakano with Liao is inappropriate. Liao 5 relates to an apparatus for reducing radial friction in a wire winding box, specifically against a communication wire. The invention is directed toward avoiding friction when the communication wire is wound back into the wire box, preventing damage to the communication wire and thus 10 increasing its lifetime.

Applicant respectfully points out that, standing on their own, these references provide no justification for the combination asserted by the Examiner.

15 "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some 20 suggestion or incentive to do so." ACS Hospital Systems Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original).

25 The cited references provide no such suggestion or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result of a hindsight view with the benefit of Applicant's

specifications. It is well-settled that this type of analysis is inappropriate:

5 "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made."

10 Seasonics v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

15 In addition, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument. The disclosure in Liao's specification and claims does not reveal functional or design choices that could possibly include that of Applicant's invention. Furthermore, the structure of the design disclosed in Nakano's specification and claims could not possibly allow for that of Applicant's invention.

20 Accordingly, it is not obvious to combine these patents in any combination to arrive at the present invention. At best it might be obvious to try such a modification, but of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103. Hybritech, Inc. v.

Monoclonal Antibodies, Inc., 231 USPQ 81, 91 (Fed. Cir. 1986).

Under the circumstances, Applicant respectfully submits that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." Id.

Applicant submits that the only "motivation" for the Examiner's combination of the references is provided by the teachings of Applicant's own disclosure. No such motivation is provided by the reference itself.

Thus, the present invention, for the first time, discloses novel methods and apparatus for ear protection and stowage to allow for comfort, easy accessibility, flexibility, and applicability to any type of environment. This represents a vast improvement over the prior art, and is not taught or disclosed anywhere in the prior art. Further, the cited references neither teach nor suggest the novel and nonobvious features of this invention.

C. 35 U.S.C. § 103

The Examiner rejected claims 21, 33 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Rozon. Rozon is directed toward a cord retraction device specifically adapted for use with window blinds.

5 Applicant respectfully submits that there is no motivation for the combination of Nakano in view of Rozon as relates to the present invention. The invention of Rozon teaches the reversible taking up of slack in cord, specifically for a pair of free-ended cords found in Venetian blinds or a

10 cord loop found in a vertical blind. In fact, Rozon acknowledges that many retraction devices already exist, but none that are effectively adapted to the requirements of window blind cord retraction devices. It would be improper to combine this reference with the system of

15 Nakano to achieve the result of the present invention. Rozon teaches the use of a thumbslide or "catch" to hold the spool in position. Since this design is intended for use with window blinds, the retraction of the cord operates mechanically different from that of the ear protection

20 device of Nakano. In Rozon, both ends of the cord are adjustable and move through the rotating spool. When the catch is engaged to retract the cord, only the excess cord is wound onto the spool, unlike Nakano which retracts the entire piece of cord. Thus, the design of Rozon, which

pertains to window blinds, is distinctly different from the invention of Nakano and it would be unobvious to combine the two inventions which relate to distinctly different fields to form the system of the present invention.

5 The Examiner rejected claim 38 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Burger. Burger relates to an apparatus for storing excess wire, cable and other cordage. The invention particularly relates to an "apparatus for storing the excess cordage 10 which often results when a radio user installs a radio at one location on the body and then connects the radio to a peripheral device which is situated elsewhere on the body." (see Col. 1, Lines 7-11)

Applicant respectfully submits that the Examiner's 15 reliance on Burger in combination with Nakano is inappropriate. It would not be obvious to combine the design disclosed by Nakano with the rotatable clip of Burger. Nakano discloses an ear protection device in an encasement structure, the design of which does not allow 20 for flexibility in placement or movement of the encasement structure. Movement or re-orientation of the encasement structure would disrupt positioning of the ear protection device in the user's ear. There would be no motivation to apply a rotatable clip to the design of Nakano because the

design of Nakano is for specific placement on a construction worker's headgear. Thus, the combination of Nakano and Burger to create the system of the present invention would not be obvious or even practical.

5 The Examiner rejected claims 1 through 9, 11 through 13, 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Liao. As discussed above with respect to the amendments to claims 15, 16, 18, 20, 22 through 32, 34, 35 and 37, Applicant respectfully
10 submits that the combination of Nakano in view of Liao is inappropriate. The invention disclosed in Liao does not relate to an ear protection system as disclosed in the present invention. The applicant has amended independent claim 1 to more clearly show the novelty of the present
15 invention with respect to Nakano. Minor changes to dependent claims have further been made to more clearly define the invention.

The Examiner rejected claims 6 and 10 under 35 U.S.C. § 103 as unpatentable over Nakano in view of Liao, and
20 further in view of Rozon. As discussed above, applicant respectfully submits that such a combination is inappropriate.

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Liao,

and further in view of Burger. As discussed above, the applicant respectfully submits that there is no motivation to combine any of these references to achieve the system of the present invention. Further, the cited references 5 neither teach nor suggest the novel and nonobvious features of this invention.

V. ADDITIONAL AMENDMENTS

The independent claims have been amended to recite "consisting of" in place of "comprising" in the preamble of 10 those claims, in the interest of more specifically defining the invention.

Dependent claims 39-43 have been added to more completely claim the present invention. The new claims are directed to specific placement of the encasement structure 15 to further distinguish the present invention from the system disclosed by Nakano, which is limited to placement of an encasement structure on a user's construction helmet. No new matter has been added. Importantly, these claims teach the ear protection system of all other pending claims 20 (as amended), with additional limitations, and therefore, are in condition for allowance for the same reasons as discussed above.

CONCLUSION

In light of the foregoing amendments and remarks,
Applicant submits that the specification, drawings, and all
pending claims are now in condition for allowance. Early
5 and favorable action is accordingly solicited.

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Date:

11/3/03

Respectfully submitted,

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